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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/810,422

03/26/2004

Patrick R. Buckley

IL-11255

8937

24981

7590

02/20/2009

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EXAMINER

SHEEHAN, JOHN P

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

02/20/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/810,422	<b>Applicant(s)</b> BUCKLEY ET AL.	
	<b>Examiner</b> John P. Sheehan	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) 2-8, 10-19, 21-25, 27-49, 51-60 and 62-93 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 20 is/are allowed.
- 6) ☒ Claim(s) 9, 26, 50 and 61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Application/Control Number: 10/810,422  
Art Unit: 1793

Page 2

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Species V in the reply filed on January 24, 2008 is acknowledged. In the response submitted July 28, 2008, applicants have amended claim 1 to recite that the magnetic pieces as being Ni-Zn-Fe-O magnetic material. In view of this amendment, the Examiner now considers that claim 1 is included in the elected claims directed to the Ni-Zn-Fe-O embodiment. Accordingly, the Examiner now considers that claims 1, 9, 20, 26, 50 and 61 read on a shape memory material body comprising a Ni-Zn-Fe-O powder. Applicants in their next response should indicate any additional claims from among product claims 1 to 82 they consider to be encompassed by the elected claims 1, 9, 20, 26, 50 and 61. Applicants are requested to refrain from merely stating that all of claims 1 to 82 now read on the elected Ni-Zn-Fe-O embodiment, but rather are requested to list only those claims that are truly encompassed by the Ni-Zn-Fe-O embodiment. Further, in listing the claims, applicants are requested to make certain that the listed claims do not include duplicate claims or claims that do not further limit the parent claims. For example, compare the limitations of claims 31 and 1, claim 40 and 1, 43 and 2, 44 and 4, 46 and 5, etc.

### ***Double Patenting***

2. The nonstatutory provisional double patenting rejection of claims 1, 9, 20, 26, 50 and 61 as being unpatentable over claims 1 to 40 of copending Application No.

10/177,225 has been overcome by the applicants' terminal disclaimer submitted December 1, 2008. It is noted that the Examiner's statement of this rejection as set forth in the Office action mailed November 14, 2008 incorrectly referred to application serial number 10/717,225. In their terminal disclaimer and response submitted December 1, 2008 applicants pointed out this error and correctly submitted a response and a terminal disclaimer correctly referring to serial 10/177,225.

***Claim Rejections - 35 USC § 112, First Paragraph***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 9, 26, 50 and 61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Each of claims 9, 26, 50 and 61 recite that the Ni-Zn-Fe-O magnetic material is a "fluid". It is well known that a fluid is a gas or a liquid (for example, see page 505 of The American Heritage Dictionary of the English Language attached to this action).

Applicants' specification does not teach one of ordinary skill in the art how to make a Ni-Zn-Fe-O magnetic material in the form of a gas or liquid nor even if a Ni-Zn-Fe-O magnetic material in the form of a gas or liquid were known how to utilize a gas or liquid

Ni-Zn-Fe-O magnetic material in the claimed invention. For example, how is a Ni-Zn-Fe-O magnetic material in the form of a gas or liquid formed into magnetic pieces as required by independent claim 1 (claim 1, the penultimate line)?

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (7:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Sheehan/  
Primary Examiner, Art Unit 1793

JPS